

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q80457

Hiroyuki IIDA

Appln. No.: 10/802,868

Group Art Unit: 2627

Confirmation No.: 5449
JOSEPH

Examiner: KLIMOWICZ, WILLIAM

Filed: March 18, 2004

For: SLIDING MEMBER

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated May 26, 2010. Entry of this Reply Brief is respectfully requested.

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STATUS OF CLAIMS

Claims 1, 2, 4 and 6-11 are pending in the application.

Claims 1, 2, 4 and 6-11 have been rejected, and are the subject of this appeal.

Claims 3 and 5 have been canceled.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

An issue on appeal is whether the Examiner improperly finally rejected claims 1, 2, 4, 6, 7 and 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP 08-031128 to Nagai (JP '128) in view of JP 2002-166401 to Tsubouchi (JP '401).

An issue on appeal is whether the Examiner improperly finally rejected claims 8-10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP '128 in view of JP '401, and further in view of JP 08-034959 A to Nakanishi (JP '959).

ARGUMENT

In response to the Examiner's Answer mailed May 26, 2010, Appellant maintains that (1) the rejection of claims 1, 2, 4, 6, 7 and 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP '128 in view of JP '401, and (2) the rejection of claims 8-10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP '128 in view of JP '401 and JP '959, should be reversed because the cited references fails to teach or suggest the claimed invention for the reasons of record and the reasons set forth in the Appeal Brief filed April 1, 2010, which is incorporated herein by reference, and further in view of the following.

It is submitted that the Examiner's Answer contains errors regarding the disclosure of JP '401 as set forth below.

The Examiner admits that the primary reference JP '128 does not disclose or teach a barrier layer that is provided between the slidable substrate and the pressure-sensitive adhesive layer, as required by claim 1 of the present application. The Examiner takes the position that providing a barrier layer between the porous substrate and adhesive layers to prevent migration of adhesive into the porous substrate is well known in the art. See the Examiner's Answer, at page 13, first paragraph.

To support his assertion that providing a barrier layer between the porous substrate and adhesive layers is well known in the art, the Examiner points to the Abstract of JP '401 as expressly and explicitly teaching forming a barrier layer to prevent an adhesive from infiltration into a surface of a porous substrate. Appellant respectfully disagrees with the Examiner's interpretation of JP '401.

In particular, in forming his assertion, the Examiner appears only considered the Abstract of JP '401, but fails to consider the entire disclosure of JP '401. In this regard, it is submitted that the entire disclosure of a reference must be considered. *See* MPEP 2141.02.

Contrary to the Examiner's assertion, when the entire disclosure of JP '401 is considered, JP '401 does not teach that all adhesive layers should be provided with a barrier layer or that all adhesive/adhesive layers sink/impregnate a porous substrate.

Rather, JP '401 only discloses providing a barrier layer on a porous substrate to solve specific recognized problems, i.e., if adhesive/adhesive layers sink/impregnate a porous substrate. JP '401 discloses at paragraph [0009] that "[S]ince some adhesives are carrying out adhesion unification in the state where it sank in...a thin wood makeup single plate on substrates, such as a plywood...Even the inside of a single plate will fully be permeated in synthetic resin liquid with the above-mentioned adhesive which sank in previously...there is a problem of it becoming impossible to obtain intensity sufficient a resin impregnation processing makeup single plate." Also, see paragraph [0010] of JP '401. In addition, in paragraph [0035] of JP '401, the type of adhesive used is a solvent type where the moisture is evaporated after being applied to the porous substrate.

Thus, JP '401 does not disclose or teach that all adhesive layers should be provided with a barrier layer, as asserted by the Examiner.

In addition, claim 6 of the present application recites that the sliding member as claimed in claim 1, wherein the barrier layer comprises a thermoplastic resin.

On page 4, 5th paragraph of the Examiner's Answer, regarding claim 6, the Examiner cites paragraph [0031] of JP '401 as disclosing a barrier layer comprising a thermoplastic resin. The Examiner's interpretation of JP '401 in this regard is also incorrect.

JP '401 discloses at paragraph [0031] that the barrier layer (2) comprises a thermosetting resin (not a thermoplastic resin).

In view of the above, it is respectfully submitted that one of ordinary skill in the art would not be motivated to modify JP '128 to provide a barrier layer between the porous substrate and adhesive layers, as proposed by the Examiner based on the teachings of JP '128 and JP '401.

For the reasons of record, the reason set forth in the Appeal Brief, and the foregoing reasons, Appellant respectfully submit that the rejections should be reversed.

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



Yan Lan
Registration No. 50,214

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

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